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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,606	02/18/2004	Shelton E. Harrison JR.		2677

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EXAMINER

LARSON, JUSTIN MATTHEW

ART UNIT PAPER NUMBER

3727

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/781,606

Applicant(s)

HARRISON, SHELTON E.

Examiner

Justin M. Larson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7 and 13-20, drawn to an electronic device holder.
- II. Claims 8-12, drawn to a method of using the electronic device holder.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process. For example, the apparatus may be configured in its case configuration in which it covers the electronic device and then may be placed in a user's bag or pocket, as opposed to then being configured to wrap around their limb.

2. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP

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§ 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

3. During a telephone conversation with Mr. Shelton Harrison on 6/28/06 a provisional election was made without traverse to prosecute the invention of I, claims 1-7 and 13-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Claim Objections***

4. In claim 1, Examiner feels that the "case member" would be more accurately claimed as a "strap member" or something to that effect, being the strap (152) as depicted in Figures 15-17.

Claim 20 is objected to because it appears as though "Personal Digital Assistant" is intended to represent a trademark because it is capitalized. Trademarks should not be used in the claims as the structure associated to the trademark may change with time.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

6. Claims 1-7 and 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 13 each recite the limitations

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"the shape of a case" and "the shaped of a wrist-mount". There is insufficient antecedent basis for these limitations in the claims.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-6 and 13-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Antaki (US 5,752,633).

Regarding claims 1, 5, and 13, Antaki discloses an apparatus for providing access to an electronic device, said apparatus comprising a case member (10), wherein said case member includes a flexible member configured to be alternately movable or wrapped into a first position (Figure 13) or a second position (Figure 14), said first position comprising the shape of a case (covers the electronic device) and said second position comprising the shape of a wrist-mount, and a fastener (16/118/29), whereby said case member can be fixed in said first or second position after having been adjusted.

Regarding claims 2 and 14, Antaki discloses an attachment mechanism (122) for removably attaching the electronic device to said case member.

Regarding claim 3, 4, 15, and 17, the attachment mechanism (122) of Antaki is an elastic strap that is movable in that it is stretchable, effectively satisfying the limitations of the claim.

Regarding claims 6 and 16, Antaki discloses an electronic device comprising an output device (light bulb of the flashlight outputs light).

Regarding claim 18, the movable coupling (122), being elastic, would certainly allow the flashlight to rotate or turn to at least some degree if some torque were to be applied to the flashlight by the user, effectively satisfying the limitations of the claim.

Regarding claim 19, Antaki discloses a loop (14) through which said flexible member can be fed so as to facilitate attachment.

9. Claims 1-6 and 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Hacker (US 5,927,210).

Regarding claims 1, 5, and 13, Hacker discloses an apparatus for providing access to an electronic device, said apparatus comprising a case member (Figure 5), wherein said case member includes a flexible member (11) configured to be alternately movable or wrapped into a first position (similar to Figure 6, however, the closed loop is formed above the object 17 rather than below as shown) or a second position (Figure 6), said first position comprising the shape of a case and said second position comprising the shape of a wrist-mount (although shown attached to a leg, could be attached to a wrist), and a fastener (12), whereby said case member can be fixed in said first or second position after having been adjusted.

Regarding claims 2 and 14, Hacker discloses an attachment mechanism (Figure 7) for removably attaching the electronic device to said case member.

Regarding claim 3, 4, 15, and 17, the attachment mechanism of Hacker is an elastic strap (17) that is movable in that it is stretchable and length adjustable, effectively satisfying the limitations of the claim.

Regarding claims 6 and 16, Hacker discloses a keyboard with input keys.

Regarding claim 18, the movable coupling, being elastic, would certainly allow the keyboard to rotate or turn to at least some degree if some torque were to be applied to the keyboard by the user, effectively satisfying the limitations of the claim.

Regarding claim 19, Hacker discloses a loop (13) through which said flexible member can be fed so as to facilitate attachment.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker in view of Boyer et al. (US 5,713,548).

Hacker discloses the claimed invention except for the electronic device being a PDA or touch-screen display. Boyer et al., however, also disclose a leg mounted electronic device carrier and teach that it is known in the art for such carriers to be used to with a PDA (col. 4 lines 50-55). It would have been obvious to one having ordinary

skill in the art at the time the invention was made to use the carrier of Hacker to secure a PDA to a user's leg, as taught by Boyer et al., in order to provide the user with easy access to their PDA.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art made of record includes carriers like that of Hacker which although are not shown in both of Applicant's configurations, are perfectly capable of being configured in both configurations

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Friday, 8am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a




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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JML  
6/28/06

  
**NATHAN J. NEWHOUSE**  
**SUPERVISORY PATENT EXAMINER**